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Paper No. 14

THERAVANCE, INC.
901 GATEWAY BOULEVARD
SOUTH SAN FRANCISCO, CA 94080

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SEP 05 2003

OFFICE OF PETITIONS

In re Application
Leadbetter et al
Application No. 09/847,042
Filed: May 1, 2001
Attorney Docket No. P-088-R

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:
: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR § 1.705)" filed May 7, 2003. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from fifty-one (51) days to one hundred five (105) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. The adjustment has been corrected to one hundred seven (**107**) days (rather than the requested one hundred five days).

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance was one hundred seven (**107**) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 24, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 51 days. Applicants timely¹ submitted the instant application for patent term adjustment (with required fee), asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance was one hundred five (105) days. Applicants state that a reply to the Office action mailed October 16, 2002 was timely filed by facsimile transmission on January 15, 2003. However, the response was not entered by the Office. Applicant, on February 11, 2003 and again on March 6, 2003, submitted duplicate copies of the reply. The Office entered the reply on March 11, 2003, and using the March 11, 2003 date, reduced the patent term adjustment by 54 days. In support thereof, applicants submit a copy of their unit's report confirming transmission of the reply on January 15, 2003 (as well as, copies of the reports for the duplicates sent February 11, 2003 and March 6, 2003).

¹ PALM records indicate that the Issue Fee payment was received in the Office on May 14, 2003.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer and that there were no circumstances in the prosecution of the application which constituted failure to engage in reasonable efforts to conclude processing or examination (other than a 2 day delay in filing the response to a Notice to File Missing Parts mailed July 2, 2001).

The Office initially determined a patent term adjustment of fifty-one (51) days based on an adjustment for PTO delay of one hundred seven (107) days pursuant to 37 CFR 1.703(a)(1) reduced by a total of fifty (56) days pursuant to 37 CFR 1.704(b) for applicants' delay of two (2) days in replying to the Notice to File Missing Parts of Application mailed July 2, 2001, and of fifty-four (54) days in replying to the non-final Office action mailed October 16, 2002. Applicants neither contest the calculation of Office delay or the reduction of two (2) days.

A review of the application history reveals that the calculation of Office delay is correct²; however, both calculations of applicant delay are incorrect.

Applicants' arguments as to the timely filing of the response to the non-final Office action are well-taken. Applicants' evidence is consistent with that required under 37 CFR 1.8(b) to show timely filing by facsimile transmission. In fact, the record supports a conclusion that the amendment, resubmitted on March 11, 2003, was accepted as timely filed on January 15, 2003 pursuant to 37 CFR 1.8(b). Ordinarily, the benefit of a certificate of mailing or transmission is not considered in calculating patent term adjustment. See § 1.704(f). However, under the circumstances, the January 15, 2003 date should have been used for the date of response in the PALM system and in calculating any patent term adjustment. Thus, the filing of the reply to the non-final Office action occurred within three months of the mail date of the Office action, and did not constitute a failure to engage in reasonable efforts to conclude prosecution or examination within the meaning of § 1.704(b). Accordingly, applicants should not have been assessed a fifty-four (54) day reduction of patent term adjustment.

Likewise, a review of the record reveals that applicants did not delay in filing a reply to the Notice to File Missing Parts of Application mailed July 2, 2001. A complete and proper reply was filed on August 6, 2001, not October 4, 2001. As this was within three months of the mail date of the Notice, this filing also did not constitute a failure to engage in reasonable efforts to conclude prosecution or examination within the meaning of § 1.704(b). Accordingly, applicants should not have been assessed a further two (2) day reduction of patent term adjustment.

² The Office first mailed an action under 35 U.S.C. 132 on October 16, 2002, fourteen months and 107 days after the filing date of the application on May 1, 2001 (beginning July 2, 2002 and ending October 16, 2002).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is one hundred seven (107) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will forward the file to the Office of Patent Publication so that a patent can be issued in a timely manner.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.



Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

Day : Thursday

Date: 9/4/2003

Time: 14:33:12

PALM INTRANET**PTA Calculations for Application: 09/847042**

Application Filing Date:	05/01/2001	PTO Delay (PTO):	107
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	56
Post-Issue Petitions:	0	Total PTA (days):	107
PTO Delay Adjustment:	56		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
29	09/04/2003	ADJUSTMENT OF PTA CALCULATION BY PTO	56		
20	04/24/2003	MAIL NOTICE OF ALLOWANCE			
19	04/24/2003	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
18	04/24/2003	NOTICE OF ALLOWABILITY			
17	01/14/2003	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
16	03/24/2003	DATE FORWARDED TO EXAMINER			
15	03/11/2003	RESPONSE AFTER NON-FINAL ACTION		54	14
14	10/16/2002	MAIL NON-FINAL REJECTION	107		-1
13	10/16/2002	NON-FINAL REJECTION			
12	10/04/2002	CASE DOCKETED TO EXAMINER IN GAU			
11	09/04/2002	CORRESPONDENCE ADDRESS CHANGE			
10	03/06/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	01/31/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	11/26/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	10/10/2001	CASE DOCKETED TO EXAMINER IN GAU			
6	10/04/2001	APPLICATION DISPATCHED FROM OIPE			
5	10/04/2001	APPLICATION IS NOW COMPLETE		2	4
4	07/02/2001	INCOMPLETE APPLICATION UNDER RULE 53(B) - FILING DATE ASSIGNED			
3	06/30/2001	CORRESPONDENCE ADDRESS CHANGE			
2	05/09/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	05/01/2001	INITIAL EXAM TEAM NN			

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